

REMARKS

The present application was filed on March 5, 2002 with claims 1-27. In a response dated August 10, 2004, Applicants amended independent claims 1, 12, 13, 20 and 23 to further clarify the subject matter of the invention.

In the outstanding final Office Action, the Examiner: (i) rejected claims 1-7, 9, 10, 12 and 23-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,815,081 to Motohashi (hereinafter “Motohashi”) in view of U.S. Patent No. 5,493,692 to Theimer et al. (hereinafter “Theimer”); and (ii) rejected claims 13-16, 21 and 22 under 35 U.S.C. §102(b) as being anticipated by Theimer.

In this response, Applicants: (i) amend independent claims 1, 12, 13, 20 and 23; and (ii) traverse the §102(b) and §103(a) rejections for at least the following reasons.

Applicants have amended pending independent claims 1, 12, 13, 20 and 23 to further clarify the subject matter of the invention. More particularly, Applicants have amended independent claims 1, 12, 13 and 20 to indicate that context is also useable to automatically modify at least one of an operating mode associated with the signal receiving device and an alert indication mode associated with a signal intended for the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification. Independent claim 23 has been amended to indicate that context is also useable to automatically modify an operating mode associated with the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification. Support for the amendment may be found throughout the present specification, see, e.g., page 14, line 18, through page 16, line 7. No new matter has been added.

The final Office Action acknowledges, at the bottom of page 2, that Motohashi fails to teach or suggest “making an environment-appropriate alert mode determination based on context provided by an environment that the user is in.” Thus, since Motohashi contains no teachings of the use of environment context, both the §102(b) rejection and the §103(a) rejection rely solely upon Theimer for support.

While Applicants do not believe that Theimer teaches or suggests making an environment-appropriate determination based on context provided by an environment that the user is in and thus fails to teach or suggest delivery selection as it is related to appropriateness to the environment, Applicants have nonetheless further clarified the independent claims to indicate that context is also useable to automatically modify at least one of an operating mode associated with the signal receiving device and an alert indication mode associated with a signal intended for the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification (claims 1, 12, 13 and 20) and that context is also useable to automatically modify an operating mode associated with the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification (claim 23).

By way of example, the present specification, at page 14, line 18, through page 16, line 7, provides some illustrative embodiments wherein context provided by the environment is used to determine an environment-appropriate mode:

It is contemplated that the device receives assistance from its environment. For example, a bluetooth-enabled device might receive a communication at the door to "sensitive" environments (also referred to as a context service environment) informing the device that it has entered an environment in which no audible modes of alert may be used or in which no modes of alert may be used. In such a situation, the cellular phone (or other device such as, for example, a personal digital assistant or a two-way pager) adjusts its behavior accordingly. It is further contemplated that for usability or other reasons, the device is configured to alert its user to the change in environment and the implications on future alerts in that particular vicinity. Additionally, the device forwards this information on to its awareness or context service or other infrastructure and does not act on the information directly. Alternatively, the device could act on the information itself and also forward the information to an awareness or context service or other component of the infrastructure. The environment might identify the type of environment it is, from a standardized list of environment types. From this information, the user could specify the preferred behavior for the specified type of environment and/or the service providers and device manufacturers could implement the required behavior for that environment.

It is contemplated that the service provider's infrastructure is modified to support such a system. For example, infrastructure installed in sensitive environments might refuse to transmit calls or messages with audible alerts or it might modify the mode of alert to a

non-audible one. Some particularly sensitive environments include those within hospitals, airplanes and blasting zones (such as appear in a highway construction site). In such environments, the use of cellular phone and other computer and communication devices might be banned. The present invention prevents the use of these devices within the sensitive environment. More specifically, transmitters within the sensitive environment may transmit a reconfiguration signal to these devices which precludes the device from transmitting further signals. Upon leaving the sensitive environment, the transmitter can send a second reconfiguration signal that returns the device back to its normal operating mode. While in the sensitive environment, the service provider could, possibly with the assistance of the transmitter, inform callers that the user is temporarily unavailable or a similar such message.

It is also contemplated that a transmitter within a sensitive environment could send a reconfiguration signal that precludes the device from operating its radio at all (even in a listen-only mode) and that causes the device to turn its radio off. In this case, a second reconfiguration signal would be ineffective and the user will need to remember to turn the radio back on upon leaving the sensitive environment. Alternatively, the device could set an alarm and query the user to determine if the user has left the sensitive environment. If the user responds in the affirmative, the device could re-enable its radio; if not, the device could reset the alarm and re-query at a later time. Also, the transmitter's reconfiguration signal could suggest a time for that alarm to go off. It is further contemplated that the reconfiguration signal might indicate that the device should turn itself off. In this case, the user will be required to turn the device back on upon leaving the sensitive environment.

While Theimer discloses concepts of selective delivery of electronic messages in a multiple computer system, context and environment, Theimer does not teach or suggest making an environment-appropriate determination based on context provided by an environment that the user is in and thus fails to teach or suggest delivery selection as it is related to appropriateness to the environment. Theimer also fails to teach or suggest that context is also useable to automatically modify at least one of an operating mode associated with the signal receiving device and an alert indication mode associated with a signal intended for the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification (claims 1, 12, 13 and 20) and that context is also useable to automatically modify an operating mode associated with the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification (claim 23).

Regarding the assertion that the combination of Motohashi and Theimer is improper, as Applicants first asserted in their previous response, it is further asserted that the additional explanation given in the final Office Action at page 5 still fails to satisfy the obviousness standard.

As stated in Applicants' previous response, the Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

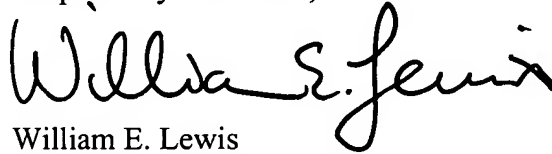
In the final Office Action at page 5, the Examiner provides the following additional statement to prove motivation to combine Motohashi and Theimer: "[i]t would have been obvious to a person of ordinary skill in the art at the time of [sic] the invention was made to include delivering the messages [sic] are selected based up on the environmental sensitive context of the user of Theimer et al. in the paging system of Motohashi with the motivation for doing so would allow [sic] the user with more privacy of receiving the message."

Applicants again submit that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner again fails to identify any objective evidence of record in either Motohashi or Theimer which supports the proposed combination. Moreover, the final Office Action actually acknowledges, at the bottom of page 2, that Motohashi fails to teach or suggest "making an environment-appropriate alert mode determination based on context provided by an environment that the user is in." Thus, it is not understandable how there could be motivation coming from Motohashi, either expressly or impliedly, to modify Motohashi to make an environment-appropriate alert mode determination based on context provided by an environment that the user is in when it is acknowledged that Motohashi fails to teach or suggest making an environment-appropriate alert mode determination based on context provided by an environment that the user is in.

For at least these reasons, Applicants assert that the pending independent claims are patentable over Theimer, alone or in combination with Motohashi. It is also asserted that the dependent claims of the present application are patentable over the cited references not only for the reasons given above but also because such dependent claims also recite separately-patentable subject matter in their own right.

In view of the above, Applicants believe that the pending claims of the present application are in condition for allowance, and respectfully request withdrawal of the §102(b) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis", written in a cursive style.

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